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**U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

**Ex parte FUMIYOSHI URANO, MASA AKI NAKAHATA,
HIROTOSHI FUJIE, and KEIJI OONO**

**Appeal 2007-0686
Reexamination Control 90/004,812
Patent 5,216,135
Technology Center 1600**

Oral Hearing Held: May 2, 2007

**Before CAROL A. SPIEGEL, SALLY G. LANE, and
MICHAEL P. TIERNEY,
Administrative Patent Judges.**

ON BEHALF OF THE APPELLANT:

**JAMES ARMSTRONG, ESQUIRE
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1 The above-entitled matter came on for hearing on Wednesday,
2 May 2, 2007, commencing at 9:00 a.m., at The U.S. Patent and Trademark
3 Office, 600 Dulany Street, Alexandria, Virginia, before Dominico
4 Quattrociocchi, Reporter.

5 JUDGE SPIEGEL: We'll start the *ex parte* hearings beginning
6 with the application of In re URANO. And we will give each side 20
7 minutes for, of course, each of the two *ex parte* hearings we have today. So
8 Mr. Tockman?

9 VOICE: I think we're here for the second one.

10 VOICE: Mr. Tockman?

11 MR. ARMSTRONG: Good morning.

12 JUDGE SPIEGEL: Good morning, sir. If you'd like to
13 introduce yourself, and please give a business card to our stenographer,
14 please. Oh, I'm supposed to do this general disclaimer too. Please turn off
15 all pagers, phones, cells, et cetera.

16 MR. ARMSTRONG: In fact, I don't have a business card with
17 me this morning.

18 JUDGE SPIEGEL: Well, just please verify that he has the
19 correct spelling of your name. Okay? You have 20 minutes, if you

1 would like to begin.

2 MR. ARMSTRONG: Okay. Good morning, and may it please
3 the Board. My name is James Armstrong. I'm here representing Wako Pure
4 Chemical. Mr. Tockman had previously handled this application during the
5 prosecution. However, I've been handling the entire reexamination.

6 I appreciate your hearing this again, as this application, this
7 reissue, reexamination, has now about a 10-year history at the Patent Office.
8 And the applicants appreciate your rehearing this again.

9 And I think the main point for hearing this reexamination again
10 is the applicants would respectfully request the Board to reconsider where
11 the examiner has gotten off the trail of where the support can be found in the
12 priority document for the claimed compounds.

13 And if I may go through that, the reasons --

14 JUDGE SPIEGEL: Well, just --

15 MR. ARMSTRONG: Yes.

16 JUDGE SPIEGEL: -- a point of clarification. When you're
17 referring to support in the priority document, are you talking about literal
18 support or support pointing us to the particular species or very narrow
19 subgenous that's being claimed?

1 MR. ARMSTRONG: I'm talking about specific support for the
2 compounds, which is found under -- specifically found word-for-word in the
3 priority document itself. And in combination with 35 USC 112, it is obvious
4 that the currently-claimed compounds are supported in the priority
5 document. What I think --

6 JUDGE SPIEGEL: But the question was more specific than
7 that. It's not merely can you find those compounds in the laundry list, but is
8 there something pointing us towards those -- that specific species and that
9 very narrow subgenous.

10 MR. ARMSTRONG: Right. I think the specific --

11 JUDGE SPIEGEL: -- is more focused.

12 MR. ARMSTRONG: Right. I think the specific language in
13 the priority document on page 14, lines 6 to 10, are the necessary blaze
14 marks, if you will, to direct the one skilled in the art to understand that the
15 applicants did have possession of the invention at the time the priority
16 document was filed. In this case, those specific lines discuss a straight-chain
17 branched or cyclic alkyl group, and then mention an R1 and R2 moiety,
18 which included the carbon atoms from 1 to 10, including alkyl groups,
19 including methyl, ethyl, propyl, butyl, and hexyl. And I think those specific

1 words are the literal support and the blaze marks under -- that would be
2 necessary for one skilled in the art under 35 USC.

3 And I think where the examiner has gotten off the trail on this
4 in the past under 35 USC is not -- is it's kind of requiring more than some
5 sort of guidance more than what is necessary under 35 USC. And it's kind
6 of a -- the *In re Ruschig* case was mentioned early in this reexamination, and
7 I feel that the analogy of the blaze marks has been over-emphasized. In fact,
8 the literal support, the language, even the priority document, are enough -- is
9 enough support for one skilled in the art to understand that the now-claimed
10 compounds are clearly supported in the priority document. There is no
11 additional requirement that the specific -- that there be any more blaze marks
12 or guidance in the priority document than what is already written.

13 JUDGE TIERNEY: Just for a moment, could you explain to me
14 the blaze mark portion? I understand the individual pieces of your claim are
15 all recited within the priority document.

16 MR. ARMSTRONG: Correct.

17 JUDGE TIERNEY: But again, why would one already skilled
18 in the art -- possess those pieces when they're put together?

19 MR. ARMSTRONG: Because this particular list is something

1 that could be understood by any organic student. It quickly sketched down -
2 - it's just a shorthand list of all of the compounds contemplated by the
3 applicants.

4 JUDGE TIERNEY: So is it your position that you possess
5 every possible compound recited within that --

6 MR. ARMSTRONG: Correct.

7 JUDGE SPIEGEL: So that when we look at page 9 of the
8 translation, in conjunction with page 14, page 9 is where the generic formula
9 1 is set forth, where it says that the two R groups are independently. They
10 may or may not be the same.

11 MR. ARMSTRONG: Um-hum.

12 JUDGE SPIEGEL: And there's a variety of possibilities here.
13 And then when you go to page 14, it starts discussing embodiments, if you
14 will, within those categories that were generally set forth on page 9.

15 MR. ARMSTRONG: But the categories set forth on page 14
16 are specific insofar as it's the -- they use the diazodisulfone formula of --
17 formula number 1 on page 9 in combination with two R moities. And
18 they're clearly -- they specifically list the possible alkyl groups, as well as
19 they could be branched --

1 JUDGE SPIEGEL: Is that enough, that they simply list them as
2 possible substitutions?

3 MR. ARMSTRONG: This is one form of -- it could be listed
4 that way. But we believe that this is another way of simply listing shorthand
5 what the possible combinations are. To one skilled in the art, it's all the
6 same -- it has all the same chemical meaning, whether you list it in
7 individual compound form or you list it as -- in groups, and specifically
8 reciting butyl and hexyl. So chemically, it isn't any different than
9 specifically listing out more compounds than what's written here. It has the
10 same chemical meaning. And certainly, the applicants have written this
11 understanding that they were dealing with a simple diazodisulfone
12 compound with two R moieties, and simply listed what those moieties would
13 be.

14 JUDGE SPIEGEL: You discussed Ruschig earlier.

15 MR. ARMSTRONG: Right.

16 JUDGE SPIEGEL: Now, Ruschig, that's the famous forest and
17 the trees --

18 MR. ARMSTRONG: Correct.

19 JUDGE SPIEGEL: -- and blaze mark sort of thing. Well, if we

1 look at the disclosure here, we've had this wonderful forest with these
2 different glens in them.

3 MR. ARMSTRONG: Correct.

4 JUDGE SPIEGEL: And we've got oaks and ashes, hickory
5 and all sorts.

6 MR. ARMSTRONG: Right.

7 JUDGE SPIEGEL: Well, actually, it's more generic than that.
8 We've got hard woods and soft woods. And then within one of these little
9 glens, we have particular types of hard woods. Even within the hard woods,
10 we have different species of hard woods. Is the fact that you can find literal
11 support just in a list, a laundry list, sufficient to point us to a specific tree in
12 this forest to tell us we want to go to that particular glen that's got hard
13 wood trees in it? And then we want to go to the oaks, and then we want to
14 go -- I don't know -- different kind of oak trees. My allergist tells me there
15 are different kinds of oak trees.

16 MR. ARMSTRONG: Sure. Your Honor, it's the applicant's
17 position that it's not a laundry list or quite such a deep and dark forest. In
18 fact, the list --

19 JUDGE SPIEGEL: Because --

1 MR. ARMSTRONG: Because the list here is alkane chemistry
2 and simple alkyl groups that could be anyone skilled in the art, or even an
3 organic chemistry student, could simply sketch out quickly what the
4 combinations would be.

5 So in that respect, it's not -- these are the necessary blaze
6 marks. They're written right here as far as butyl hexyl. They're written
7 right here. And someone could use this literal language, combine it with the
8 diazodisulfone compound, and that would give you the specific trees that
9 you were looking for.

10 So it's not really a huge laundry list that would take a Ph.D.
11 chemist to understand. In fact, it's a much simpler list.

12 JUDGE LANE: Do you know how big that list is? Have you
13 done the calculation to see how many compounds are encompassed by that
14 general formula?

15 MR. ARMSTRONG: Your Honor, I have not. However, just
16 from reading the list from the top down, it's very simple chemistry. And
17 one skilled in the art could quickly understand with just substituting the R
18 groups with, you know, four carbon atoms or six carbon atoms.

19 JUDGE SPIEGEL: Why would you substitute both R groups

1 with the same moiety?

2 MR. ARMSTRONG: Again, these are -- it's because it's the
3 shorthand way it is written. That's one of the possible combinations. You
4 could substitute both R groups with the same moiety.

5 JUDGE TIERNEY: Now, can you address Fujikawa? Because
6 I've noted in Singh v. Brake, Fujikawa is discussed by the Federal Circuit as
7 -- proposition that disclosure of a generic -- structure with four variable
8 groups, each of which could independently be chosen from a list of
9 functional groups, provided insufficient written descriptive support for a
10 claim directed to a subgeneric structure having a single combination of the
11 four groups. So that's one of four, essentially.

12 But I'm looking at your specification, and I see much more than
13 four. Can you tell me why your case is much more -- why it's a better
14 written description than that which was provided in Fujikawa?

15 MR. ARMSTRONG: The reason is the chemistry here is much
16 simpler, and we're talking about simple alkyl groups. And simply, it says
17 it's either branched, cyclic, or straight-chained, and you have two R
18 moieties, and the alkyl groups are listed. And just -- it's because of the
19 chemistry, one skilled in the art would easily recognize that the compounds

1 listed here in shorthand are -- were in possession at the time the priority
2 document was filed. This isn't a complicated chemistry or -- I thought the --
3 or there are other cases that dealt with a lot more complicated chemistry.
4 But this is very, very simple organic chemistry.

5 So using the standard of one skilled in the art under
6 35 USC 112, it's clearly that the specific groups that were listed here are the
7 necessary blaze marks that one would need to select the compounds that are
8 claimed.

9 JUDGE TIERNEY: Okay.

10 MR. ARMSTRONG: Thank you very much.

11 (Whereupon, the proceedings at 9:30 a.m. were concluded.)